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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/311,674 05/13/99 KATZ

P WMA-96-015AA

025537

TM02/0411

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EXAMINER

CHOL, K
ART UNIT PAPER NUMBER

2163
DATE MAILED:

04/11/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.

09/311,674

Applicant(s)

KATZ, PENINA

Examiner

Kyle J. Choi

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-15, 17-23 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 8, 16 and 24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. The following is a second Non-Final Office Action in response to communication received on April 17, 2001. No amendments have been made to the claims. Claims 1-29 are now pending in this application.

Information Disclosure Statement

2. Receipt of the Information Disclosure Statement filed April 17, 2001 is acknowledged but none of the art listed thereon has been considered. In particular, none of the references submitted have a valid publication date for it to be construed as valid prior art. Hence, the references have been placed in the file but were not considered for examination purposes.

Double Patenting

3. Receipt of three separate terminal disclaimers filed April 17, 2001 is acknowledged. Accordingly, the prior rejections under the judicially created double patenting have been withdrawn.

Response to Arguments

4. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

Scope of the Invention

5. Independent claims 1, 9, 17, 25-29 recite either a computer program product, method, or system for generating a report of telephone calls received. These claims, as broadly interpreted as reasonable, recite nothing more than a system, method, and computer program product that determines the originating source of a call (e.g., location, telephone number, etc.), compares this information to some reference data, time-stamps the call, and generates a report of the calling activity. It is based on this interpretation that the following rejection is applied.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof

by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-5, 9-10, 12, 15, 17-21, 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by **McConnell**.

McConnell (US Pat. No. 5,436,957) discloses a system and method of controlling access of telephone lines. In general, the system takes the originating call information (e.g., location and telephone number) with the user's specific information (e.g., access code) and compares this information with the information in a database to give access to the system (col. 4, lns. 23-40).

In particular, the system takes calling information from a subscriber using Transaction Capabilities Applications Protocol (TCAP) on an Advanced Intelligent Network (AIN). TCAP information from a call originating source includes calling party's address, primary carrier ID, alternate carrier ID, second alternate carrier ID, routing number, and destination number (starting col. 7, ln. 64). The generated TCAP includes a time stamp indicating the time of call (col. 13, ln. starting ln. 36). The system can require further identification information such as a product ID and password (e.g., col. 10, ln. 45). The system checks the originating call information and

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the identification information to give access to the system. The system further includes a Data and Reporting System (D&RS) that generates Station Message Detail Reports (SMDR) for all calls made on the system from the identified subscriber lines. The report indicates when a user requested the communication service, what line the user used, the product and password used, and where the user called from (col. 15, starting ln. 27).

With regard to the limitation that the callers are "employees", McConnell's system do not preclude that the identification codes given to the system users are for employee use. Indeed, the relationship of a user to the system is irrelevant unless there is recitation in the claims breathing life into such a limitation.

Likewise, with regard to the limitation that the call originating sites are "work sites", McConnell's system already detects the call origination point. Whether the call is made from a place of employment or not is irrelevant unless there is recitation in the claims breathing life into such a limitation.

Therefore, claims 1-5, 9-10, 12, 15, 17-21, 25-29, when interpreted as broadly as reasonable, is anticipated by McConnell for the reasons stated above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 7, 11, 13, 14, 22, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **McConnell**.

McConnell teaches the computer program product as recited in independent claims 1, 9, and 17 as described above.

McConnell does not specifically teach that the caller information is taken from a Caller ID nor indicates that the caller is calling from a cellular phone.

McConnell does teach that caller location and phone number is detected. Hence, this constitutes a Caller ID system. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to have used Caller ID information to detect the origin of a call since McConnell already detects the caller's originating phone number

automatically and this is essentially the same as using Caller ID.

Furthermore, since McConnell's system detects the location of the originating call based on a database, any phone numbers registered on a cellular switch would be detected when the originating number is compared with the information in the database. Hence, it would have been obvious for one of ordinary skill in the art at the time of the invention to have detected cellular phone callers since McConnell's system already uses the method of detecting the location of the originating call based on information in a database.

Allowable Subject Matter

10. Claims 8, 16, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

None of the art of record, individually or in combination, teach generating a report of employees calling in from valid work sites in the manner recited in these claims.

The closest relevant art are patents all owned by the present assignee. Due to the terminal disclaimers filed by the assignee, these references are no longer valid as prior art.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Sakurai et al.** (US Pat. No. 5,586,172) discloses a telephone exchange system that automatically detects calling location information and allows access based on password/user ID information.

- **Black et al.** (US Pat. No. 5,740,234) discloses a telephone call monitoring system that automatically detects calling information and either routes or blocks the call based on criteria in a database.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kyle J. Choi** whose telephone number is (703)306-5845. The examiner can normally be reached on **Monday-Friday, 8:00am-4:30pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Tariq Hafiz** can be reached on (703)305-9643. The fax phone numbers for the organization where this application or proceeding is assigned is (703)308-6306 for regular and After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703)308-6306 (informal or draft communications should be labeled "PROPOSED" or "DRAFT").

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA., 4th floor receptionist.

Kyle Choi



Patent Examiner
Art Unit 2163

April 9, 2001